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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,511	11/29/2001	Doron Cohen	IL920010047US1	4997

7590

05/31/2005

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EXAMINER

PHAN, TAM T

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,511

Applicant(s)

COHEN ET AL.

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Amendment received 04/04/2005 has been entered. Claims 1-17 are previously presented.
2. Claims 1-17 are presented for examination.

***Priority***

3. No priority claims have been made.
4. The effective filing date for the subject matter defined in the pending claims in this application is 11/29/2001.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathur et al. (U.S. Patent Number 6,581,072), hereinafter referred to as Mathur, in view of Tripp et al. (U.S. Patent Number 6,516,337), hereinafter referred to as Tripp.
7. Regarding claim 1, Mathur disclosed a method for indexing dynamic documents on an off line intermediary [index server] and transfer the index to a personal digital assistant (PDA) [user computer system of varying types including a portable computer, a portable data assistant, etc.] (Figure 3, column 7 line 53-column 8 line 12, column 9 lines 49-62), the method comprises the steps of: creating off-line, from the dynamic documents, a

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static index (column 10 lines 13-26, lines 48-56); and transferring said off-line static index to said PDA (Figure 3, column 7 line 57-column 8 line 12, column 9 lines 49-62,).

8. Mathur taught the invention substantially as claimed. However, Mathur did not expressly teach transferring dynamic documents from the PDA to the off-line intermediary for indexing.

9. Mathur suggested exploration of art and/or provided a reason to modify the method with additional feature to include transferring dynamic documents from the PDA to the off-line intermediary for indexing (column 8 lines 21-38, column 10 lines 48-56, column 18 lines 1-12).

10. Tripp disclosed a method for transferring dynamic documents from the PDA [source computer] to the off-line intermediary [cataloging site] for indexing (column 2 lines 50-65, column 5 lines 36-65, column 6 lines 3-17).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Mathur with the teachings of Tripp to include transferring dynamic documents from the PDA to the off-line intermediary for indexing in order to allow indexing of local documents for faster retrieval (Tripp, column 3 lines 19-34) since as local storage for personal computers increases, the local utility takes too long to retrieve the desired information (Tripp, column 3 lines 19-34).

12. Regarding claim 2, Mathur disclosed a method wherein said intermediary is selected from the group consisting of a desktop, a server, and a web server (column 9 lines 49-62, column 7 lines 46-62, column 10 lines 13-26).

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13. Regarding claim 3, Tripp disclosed a method further comprising the step of: updating said off-line static index with said dynamic documents that have been modified, added, or deleted after said step of creating, and from time to time, transferring said off-line updated static index to said PDA [local master index server] (Abstract, Figure 3, column 2 lines 50-65).

14. Regarding claim 4, Tripp disclosed a method wherein said from time to time is synchronization of said PDA [local master index server] with said off-line intermediary (column 1 lines 38-51, column 2 lines 50-65).

15. Regarding claim 5, Tripp disclosed a method further comprising the step of: indexing on-line a dynamic index of said dynamic documents (column 3 lines 35-52, column 10 line 62-column 11 line 14).

16. Regarding claim 6, Mathur and Tripp combined disclose a method for searching text on a personal digital assistant (PDA) (Mathur, Figure 3, column 6 lines 49-57, column 12 line 60-column 13 line 8), the method comprises the steps of: searching an on-line static index and compiling therefrom static search results (Mathur, column 10 lines 13-26, lines 48-56); searching a dynamic index and compiling therefrom dynamic search results (Tripp, Figure 5, column 3 lines 35-52); and merging said static search results with said dynamic search results (Tripp, Figures 3, 5, column 1 lines 38-51, column 2 lines 50-65).

17. Regarding claim 7, Mathur and Tripp combined disclose a method for indexing and searching text on a personal digital assistant (PDA) (Mathur, Figure 3, column 6 lines 49-57, column 12 line 60-column 13 line 8), the method comprises the steps of:

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creating off-line a static index of dynamic documents for transfer to said PDA (Mathur, column 10 lines 13-26, lines 48-56); and searching on said PDA, said static index and an on-line dynamic index, wherein said step of creating is independent from said of searching (Mathur, column 6 lines 49-57, column 12 line 60-column 13 line 8; Tripp, column 3 lines 35-52, column 6 lines 46-52).

18. Regarding claim 8, Mathur and Tripp combined disclose a method for indexing text on a personal digital assistant (PDA) (Figure 3, column 7 line 53-column 8 line 12, column 9 lines 49-62), the method comprises the steps of: creating off-line a static index (Mathur, column 10 lines 13-26, lines 48-56); transferring said off-line static index to said PDA (Tripp, column 2 lines 50-65, column 5 lines 36-65, column 6 lines 3-17); from time to time, updating said off-line static index with dynamic text from said PDA (Tripp, Abstract, Figure 3, column 2 lines 50-65); and updating said on-line static index with said updated off-line static index (Tripp, column 1 lines 38-51, column 2 lines 50-65).

19. Regarding claim 9, Mathur and Tripp combined disclose a method wherein said dynamic text is text on said PDA that has been added or modified after said step of creating (Mathur, column 9 lines 48-62, column 10 line 66-column 11 line 22; Tripp, column 1 lines 38-51, column 2 lines 50-65)

20. Regarding claim 10, Tripp disclosed a method further comprising the step of: creating an on-line dynamic index from said dynamic text (column 3 lines 35-52).

21. Regarding claim 11, Tripp disclosed a method further comprising the steps of: detecting when the dynamic index exceeds predefined limits; and sending a signal (column 7 lines 20-35, column 11 lines 4-14, column 17 lines 38-46).

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22. Regarding claim 12, Tripp disclosed a method wherein said signal comprising a warning to generate a new, merged static index (column 5 lines 62-65, column 9 lines 43-56).

23. Regarding claim 13, Tripp disclosed a method wherein said predefined limits are selected from the group consisting of predefined limits for search time, document capacity, or number of dynamic document (column 6 lines 46-52, column 7 lines 32-35).

24. Regarding claim 14, Mathur and Tripp disclosed a personal digital assistant (PDA) comprising: an updatable static index (column 10 lines 56-column 11 line 22); and a dynamic index (Tripp, column 2 lines 50-65, column 3 lines 35-52).

25. Regarding claim 15, Mathur disclosed a PDA wherein said updatable static index is created off-line (column 8 lines 48-62, column 10 lines 14-26, lines 48-56, column 10 line 66-column 11 line 4).

26. Regarding claim 16, Mathur and Tripp combined disclose a PDA further comprising: a search engine for searching said static index (Mathur, column 8 lines 48-62, column 12 line 65-column 13 line 8, column 13 lines 22-29) and said dynamic index (Tripp, column 1 lines 52-60, column 3 lines 35-52).

27. Regarding claim 17, Tripp disclosed a PDA further comprising: an on-line indexer for creating said dynamic index (column 3 lines 35-52, column 8 line 60-column 9 line 10).

28. Since all the limitations of the claimed invention were disclosed by the combination of Mathur and Tripp, claims 1-17 are rejected.

***Response to Arguments***

29. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

30. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

***Conclusion***

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



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